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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RAMIREZ, DELIA M

ART UNIT PAPER NUMBER

1652

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,787

Applicant(s)

YUAN, CHONG-SHENG

Examiner

Delia M. Ramirez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

Claims 1-50 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I-LXII. Claims 1-35, drawn to a method for assaying homocysteine, S-adenosylhomocysteine or adenosine with a mutant SAH hydrolase which comprises the amino acid sequence set forth in SEQ ID NO: 1 and comprises the mutation R38E, C53S, L54G, T57G, T57S, E59D, N80G, S83G, Y100T, K121A, D131E, D134E, E155G, T157G, T158Y, T159Y, N181D, N181A, D190A, N191A, L214A, Y221S, K226A, F235S, I240L, N248A, D263G, G269D, R285D, D292G, H301T, K309R, K322G, R329A, L347F, L347Y, L347I, M351A, H353R, S361G, F362S, Y379S, L386A, K388G, H398A, K401R, K401D, T407S, L409G, S420T, P424A, F425S, P427A, D428G, H429A, Y430T, R431K, R431G, Y432S, Y432A, Y432F, or a single combination thereof, respectively, classified in class 435, subclass 18.

LXIII-CXXIV. Claims 36-40, 48-50, drawn to a mutant SAH hydrolase, a fusion protein comprising said hydrolase and a kit comprising said hydrolase, wherein said hydrolase comprises the amino acid

sequence set forth in SEQ ID NO: 1 and comprises the mutation R38E, C53S, L54G, T57G, T57S, E59D, N80G, S83G, Y100T, K121A, D131E, D134E, E155G, T157G, T158Y, T159Y, N181D, N181A, D190A, N191A, L214A, Y221S, K226A, F235S, I240L, N248A, D263G, G269D, R285D, D292G, H301T, K309R, K322G, R329A, L347F, L347Y, L347I, M351A, H353R, S361G, F362S, Y379S, L386A, K388G, H398A, K401R, K401D, T407S, L409G, S420T, P424A, F425S, P427A, D428G, H429A, Y430T, R431K, R431G, Y432S, Y432A, Y432F, or a single combination thereof, respectively, classified in class 435, subclass 195.

CXXV- CLXXXVI. Claims 41-47, drawn to a polynucleotide encoding a mutant SAH hydrolase, host cells, vectors and a method of producing said hydrolase, wherein said hydrolase comprises the amino acid sequence set forth in SEQ ID NO: 1 and comprises the mutation R38E, C53S, L54G, T57G, T57S, E59D, N80G, S83G, Y100T, K121A, D131E, D134E, E155G, T157G, T158Y, T159Y, N181D, N181A, D190A, N191A, L214A, Y221S, K226A, F235S, I240L, N248A, D263G, G269D, R285D, D292G, H301T, K309R, K322G, R329A, L347F, L347Y, L347I, M351A, H353R, S361G, F362S, Y379S, L386A, K388G, H398A, K401R, K401D, T407S, L409G, S420T, P424A, F425S, P427A, D428G, H429A, Y430T,

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R431K, R431G, Y432S, Y432A, Y432F, or a single combination thereof, respectively, classified in class 536, subclass 23.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-LXII and LXIII-CXXIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Groups LXIII-CXXIV can be used to generate antibodies as well as in the method of Groups I-LXII.
3. Inventions I-LXII and CXXV- CLXXXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the DNA of Inventions CXXV- CLXXXVI is neither used nor made by the method of Inventions I-LXII.
4. Groups LXIII-CXXIV and CXXV- CLXXXVI each comprise a chemically unrelated structure capable of separate manufacture, use, and effect. The DNAs in Groups CXXV- CLXXXVI each comprise an unrelated nucleic acid sequence whereas the proteins of Groups LXIII-CXXIV each comprise an unrelated amino acid sequence. The DNA of Groups CXXV- CLXXXVI has other uses besides encoding the proteins of Groups LXIII-CXXIV, such as a hybridization probe or in gene therapy. Furthermore, the proteins of Groups LXIII-CXXIV can be prepared by processes which are materially different from recombinant DNA expression of

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Groups CXXV- CLXXXVI, such as by chemical synthesis, or by isolation and purification from natural sources.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Due to the extremely large number of combinations which can result from the list of mutations recited in claims 7, 41 and 48, it is not possible to recite all of them in the instant Office Action. As indicated above, Groups LXII, CXXIV and CLXXXVI are directed to a method, a polypeptide or a nucleic acid wherein the mutant SAH hydrolase comprises a single combination of the mutations recited in claims 7, 48 or 41, respectively. Therefore, if Groups LXII, CXXIV or CLXXXVI are elected, Applicants are requested to specifically indicate the combination which is elected.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement can be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Applicants are requested to submit a clean copy of the pending claims (including amendments, if any) in future written communications to aid in the examination of this application.

10. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652



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SUPERVISORY PATENT EXAMINER
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DR
July 14, 2003